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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/609,622	07/05/00	SUNVOLD G	IAM 0602 PA

HM22/0126
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EXAMINER	
COE, S	
ART UNIT	**PAPER NUMBER**
1651	5

DATE MAILED: 01/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File Copy

Office Action Summary	Application No.	Applicant(s)	
	09/609,622	SUNVOLD ET AL.	
	Examin r	Art Unit	
	Susan Coe	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-9 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 5 .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

1. Claims 1-13 are currently pending in this application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, drawn to a composition for promoting weight loss, classified in class 424, subclass 655.

II. Claims 10-13, drawn to a process for promoting weight loss, classified in class 424, subclass 655

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a different process, such as the use of vitamin A as an antioxidant.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Ms. Susan Luna on January 17, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 are

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Claims 1-9 are examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1 and 2 are rendered indefinite by the term "low." This term is indefinite because "low" is a relative term and applicant has not stated what glycemic index numbers would be considered to be a low value.

8. Claims 3, 6, and 7 are rendered indefinite because it is not clear how applicant intends for the total diet of a human to be calculated accurately.

9. Claim 9 is indefinite because it is not clear what types of protein would be considered to be encompassed by the term "crude." In addition, the term "total" in referring to the dietary fiber is confusing. The meaning of this term in regards to the dietary fiber is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,714,472.

Claim 1 is drawn to a composition comprising L-carnitine, chromium, and vitamin A.

US '472 teaches a composition that contains L-carnitine, chromium, and vitamin A (see column 7/8, "Formula Example No. 3").

US '472 does not explicitly disclose that their composition has the ability to promote weight loss; however, since the ingredients in the composition taught by US '472 are identical to the ingredients in the claimed invention, the composition of US '472 would inherently have the same effects on the body as the claimed invention.

11. Claims 1, 2, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,104,677.

Claims 1, 2, and 8 are drawn to a composition comprising L-carnitine, chromium, vitamin A, and a carbohydrate source. The carbohydrate source is a corn or barley grain.

US '677 teaches a composition that contains carnitine, chromium, vitamin A, and fiber (see Table XV). The fiber can be corn bran or derived from barley (see column 3, lines 25-30).

US '677 does not explicitly disclose that their composition has the ability to promote weight loss; however, since the ingredients in the composition taught by US '677 are identical to the ingredients in the claimed invention, the composition of US '677 would inherently have the same effects on the body as the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,626,849, the Purina CNM Veterinary Product Guide (published in 1994 by the Ralston Purina Company), and US Pat. No. 5,240,962.

US '849 teaches using L-carnitine and chromium to cause weight loss.

The Purina Product Guide teaches a food for obese dogs that causes weight loss by restricting calories and fat while being high in dietary fiber. The dry food contains 21.17% protein, 5.6% fat, and 14.14% fiber. The ingredients of the dry food include ground corn and vitamin A (see pages 16 and 17).

US '962 teaches that corn, sorghum, and barley grains are appropriate sources of carbohydrates to administer in a weight loss regimen (see column 5, lines 30-34).

These references show that it was well known in the art at the time of the invention to use chromium, L-carnitine, vitamin A, corn, sorghum, and barley in weight loss compositions. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in weight loss compositions, an artisan of ordinary skill would have a reasonable expectation that a combination of these substances would also be useful in creating weight loss compositions. Therefore, the artisan would have been motivated to combine chromium, L-carnitine, vitamin A, corn, sorghum, and barley into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more

than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

These references together teach a composition comprising chromium, L-carnitine, vitamin A, corn, sorghum, and barley; however, they do not specifically disclose adding the ingredients in the specific amounts claimed. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been routine for an artisan of ordinary skill to determine the optimal amount of each ingredient in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

13. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 7:30 to 5:00 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC
January 22, 2001

FRANCISCO PRATS
PRIMARY EXAMINER